

### **REMARKS**

Claims 1-28 are pending. Reconsideration and allowance of all pending claims are respectfully requested in light of the following remarks.

#### **Objections to the Specification**

The title of the application has been objected to as not being descriptive. In response, Applicant has amended the title of the application has been amended as suggested by the Examiner and therefore respectfully requests that the objection be withdrawn.

#### **Rejections under 35 U.S.C § 101**

Claims 1-28 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. In response, Applicant has amended the claims to overcome the rejection and therefore respectfully request that the rejection be withdrawn.

#### **Rejections under 35 U.S.C § 103(a)**

Claims 1-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 5,966,547 to Hagan et al. ("Hagan") in view of Parlante (Linked List Basics). Applicants respectfully traverse the subject rejection on the grounds that the cited references are defective in establishing a prima facie case of obviousness with respect to the pending claims.

As the PTO recognizes in MPEP § 2142:

*The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.*

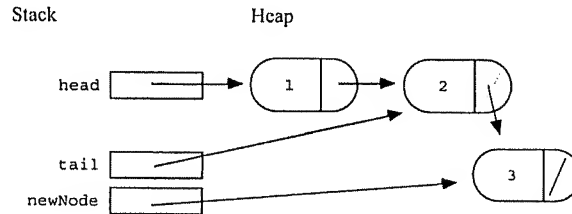
It is submitted that, in the present case, the Examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. **Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Hagan and Parlante references cannot be applied to reject independent claims 1, 11, and 15 under 35 U.S.C. § 103 because, even when combined, the references do not teach the claimed subject matter. In particular, the cited references fail to teach or suggest at least the following element as recited in each of independent claims 1, 11, and 15:

*selectively executing an add to end function for adding a new element to the queue even when the queue is in a locked state in which a queue head pointer is null and a queue tail pointer does not point to the queue head pointer*

The Examiner concedes that Hagan fails to teach this element and cites section 3, part 4, of Parlante as doing so. Applicant respectfully traverses the Examiner's position and this regard and submits that, as clearly illustrated in the Figure provided in the cited portion, which is reproduced below for ease of reference, Parlante teaches adding a node to the end of a queue when the head pointer ("head") points to the first node("1"); i.e., is not null, as required by claims 1, 11, and 15.



Accordingly, while Parlante may arguably teach at section 3, part 4, adding a node to the end of a queue, Parlante fails to teach doing so even when the queue is in a locked state, as clearly required by the claims.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness with respect to the pending claims has clearly not been met, and the rejection under U.S.C. §103 should be withdrawn.

## 2. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Hagan and Parlante references cannot be applied to reject independent claims 1, 11, and 15 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*... the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. ... The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Hagan nor Parlante teaches, or even suggests, the desirability of the combination of the teachings therein as specified above and as recited in claims 1, 11, and 15. Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

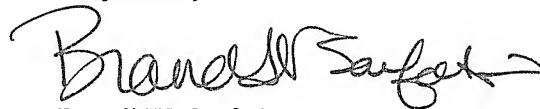
In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1, 11, and 15. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**Conclusion**

It is clear from the foregoing that all of the pending claims are in condition for allowance. An early formal notice to that effect is therefore respectfully requested.

Respectfully submitted,



Brandi W. Sarfatis  
Registration No. 37,713

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HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 214/651-5896  
Facsimile: 214/200-0948  
Client Matter No.: 26530.91/IDR-666

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Debbie Ludwig  
Debbie Ludwig